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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,811	07/27/2000	Kotaro Oami	5000-4777	9671
27123	7590	01/03/2006	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			RHEE, JANE J	
			ART UNIT	PAPER NUMBER

1745

DATE MAILED: 01/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/626,811

Applicant(s)

OAMI ET AL.

Examiner

Jane Rhee

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/22/2005 has been entered.

### ***Rejections Withdrawn***

2. The 35 U.S.C. 102(b) rejection of claims 7,10-11,13-14 anticipated by Gordon has been withdrawn due to applicant's amendment filed on 11/22/2005.
3. The 35 U.S.C. 103(a) rejection of claims 8-9, 12 over Gordon in view of Keng has been withdrawn due to applicant's amendment filed on 11/22/2005.
4. The 35 U.S.C. 102(b) rejection of claim 17 anticipated by Gordon has been withdrawn due to applicant's amendment filed on 11/22/2005.

### ***New Rejections***

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 7-11,13-14,17 are rejected under 35 U.S.C. 102(e) as being anticipated by Castle et al. (6185812).

As to claim 7, Castle et al. discloses a resin panel body (figure 2 number 21), an insert film (figure 2 numbers 20,23,22 combined) arranged on a surface of the resin panel body (figure 2 number 21), the insert film comprising a resin film (figure 2 number 21), a first binder layer formed on the surface of the resin film (figure 2 number 23), a printed part formed on the first binder layer (figure 2 number 6), a second binder layer (figure 2 number 22) formed so as to seal the printed part in co-operation with the first binder layer (figure 2 number 23) wherein, the second binder layer directly contacts both the printed part along a surface of the printed part which faces the resin panel body and the first binder layer along a periphery of the printed part (figure 2 number 22, 6), wherein the first binder layer, the printed part and second binder layer are formed in this order (figure 2 numbers 23,6,22); and wherein the printed part adheres to the first binder (figure 2 number 23) and to the second binder layer (figure 2 number 22) and wherein the entire printed part consists entirely of ink (col. 1 line 16). As to claim 8, Castle et al. discloses that the resin panel body is directly adhered to the resin film at an outer side of the periphery of the first binder (figure 2 number 21). As to claim 9, Castle et al. discloses that the second binder layer covers the periphery of the first binder layer to directly adhere to the resin film (figure 2 number 22) and wherein the panel body (figure 2 number 21) directly adheres to the resin film on an outer side of the periphery

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of the second binder layer (figure 2 number 22,21). As to claim 10, Castle et al. discloses that the resin panel is a window (col. 1 line 11). As to claim 11, Castle et al. discloses that the material of the resin panel body is the same as that of the resin film (col. 6 lines 15-16 states that there can be 5 plies of glass, one of plies can be the resin panel body and the other ply can be a resin film). As to claim 13, Castle et al. discloses that the periphery of the second binder layer is printed to overlap the periphery of the first layer (figure 2 numbers 23,22). As to claim 14, Castle et al. discloses that the printed part is coated along the periphery of the insert film (figure 2 number 6). As to claim 17, Castle et al. discloses that the printed part are ice melted heat wires (col. 1 lines 10-25).

Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the

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product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation wherein the resin body is integrally molded with the insert film by inserting molding so that a surface of the resin film of the insert film at the side on which a printed part is formed faces an inside of the resin panel is a method of production and therefore does not determine the patentability of the product itself.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castle et al.

Castle et al. discloses the resin panel described above. Castle fails to disclose that the resin body and the resin film is made from polycarbonate. Castle teaches that the resin body and the resin film can be made from polyurethane or glass materials (col. 6 lines 15-17). Polyurethane is type of plastic and glass is a transparent material. Polycarbonate is a transparent plastic. Therefore, It would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Castle with polycarbonate as the resin panel body and resin film since it has been held

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to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin 125 USPQ 416.

***Response to Arguments***

7. Applicant's arguments with respect to claims 7-14,17 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Rhee whose telephone number is 571-272-1499. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jane Rhee  
12/22/05

  
PATRICK JOSEPH RYAN  
SUPERVISORY PATENT EXAMINER